

Patent Docket P0943

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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8/25/97

In re Application of Dr. Ross G. Clark et al. Serial No.: 08/445,805 Filed: 22 MAY 1995 For: METHOD OF ADMINISTRATION OF IGF-I	Group Art Unit: 1811 Examiner: Lynn Touzeau
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TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTINGREJECTION OVER A PRIOR PATENT

Assistant Commissioner of Patents  
Washington, D.C. 20231

Sir:

Your petitioner, Genentech, Inc., having a place of business at 460 Point San Bruno Boulevard, South San Francisco, California 94080-4990 in the county of San Mateo has reviewed the evidentiary documents set forth hereinbelow and certifies to the best of Genentech's knowledge and belief that title in and to the herein application and in the referenced U.S. Patent No. 5,565,428 reside in Genentech, Inc.

Your petitioner, Genentech, Inc., represents that it is the owner of the entire right, title, and interest in and to application U.S. Serial No. 08/445,805, filed May 22, 1995, by virtue of an assignment recorded on September 21, 1995 at Reel 7651, Frame 0349, and is also the owner of the entire right, title and interest in and to U.S. Patent No. 5,565,428, filed May 22, 1995 and issued October 15, 1996, by virtue of an assignment recorded on September 21, 1995 at Reel 7660, Frame 0733.

Your petitioner hereby disclaims the terminal part of any patent granted on the herein application Serial No. 08/445,805 that would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of said Patent No. 5,565,428, and hereby agrees that any patent so granted on the herein application 08/445,805 shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent No. 5,565,428, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

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Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of Patent No. 5,565,428 in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above. Petitioner reserves the right to extend the shortened term of any patent granted on the above-identified application due to regulatory delays pursuant to 35 USC §156.

The undersigned is empowered to act on behalf of and as a recognized officer, representative and petitioner of the assignee, Genentech, Inc.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

The Commissioner is authorized to charge the statutory fee of \$110.00 required for filing this Disclaimer to Deposit Account No. 07-0630. Please charge any deficiency or credit any overpayment to Account 07-0630. A duplicate of this sheet is enclosed.

Respectfully submitted,  
GENENTECH, INC.

Date: June 2, 1997

By: Janet E. Hasak  
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